

RUNE  
Serial No. 09/638,858

Atty Dkt: 2380-163  
Art Unit: 2664

### **REMARKS/ARGUMENTS**

Reexamination of the captioned application is respectfully requested.

#### **A. SUMMARY OF THIS AMENDMENT**

By the current amendment, Applicants basically:

1. Respectfully traverse an apparent written description rejection of claims 7-12 under 35 USC §112, first paragraph.
2. Amend claims 7, 9, and 11.
3. Add new claims 13 - 18.
4. Respectfully traverse all prior art rejections.

#### **B. THE WRITTEN DESCRIPTION REJECTION**

Claims 7 – 12 appear to have sustained a written description rejection under 35 USC §112, first paragraph. The Office Action alleges that "nothing in the original disclosure supports a "low activity state" as claimed by applicant".

Applicants implore the Examiner to read page 7 carefully, in conjunction with the remainder of the specification. Clearly the specification is concerned with signaling which occurs in conjunction with a URA update. See, for example, the URA Update scenario described with reference to Fig. 5 and beginning on page 10, line 14. The Examiner is pointed to page 7 for an understanding that the URA update procedure is performed when the UE is in a "URA connected" state (see page 7, line 24 – 26). On page 7, lines 12 – 13, the "URA connected" state is equated to a "low activity state". Thus, in providing written description, e.g., of what happens during URA update, the specification also provides written description for the fact that during the signaling of claims 7 – 12, the user equipment unit can be in the low activity state.

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The Examiner is further referred to page 3, second full paragraph, which states in its entirety (and with emphasis added):

User equipment units that are having *low activity* (no user data transfer) at the moment may switch to a "*URA Connected*" state. When in "*URA Connected*" state the user equipment unit will only report change in its location when moving from one URA to another. *The present invention is intended for, but not limited to, cellular networks, where the existence of URAs or equivalent allows the user equipment unit to remain "connected" with the network in a low activity state utilizing a minimum of radio interface resources.*

Applicants trust that the above discussion disposes of the rejection for the sake of the record.

Yet, as a practical matter, in retrospect the phrase "in a low activity state" is not deemed necessary for patentability of the claims, and has been deleted by amendment from claims 7, 9, and 11. Applicants reserve the right, if subsequently deemed necessary, to reassert the canceled phrase "in a low activity state".

## B. PATENTABILITY OF THE CLAIMS

Claims 1, 3, and 5 stand rejected under 35 USC 102(e) as being anticipated by U.S. Patent 6,131,030 to Schon et al and claims 2, 4 and 6 stand rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 6,131,030 to Schon et al as applied to claims 1, 3 and 5, and further in view of U.S. Patent 6,216,004 to Tiedemann, Jr. et al.

Each of Applicants independent claims concern an overlapping routing area. The claims expressly define the overlapping routing area as comprising a cell controlled by the first radio network controller and at least one cell controlled by another of the plural radio network controllers.

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U.S. Patent 6,131,030 to Schon et al does not refer to or mention in the slightest an overlapping routing area. Contrast Applicants' Fig. 5, for example, which shows overlapping routing area 5, with Schon's Fig. 1 which has no overlapping routing area at all.

The Office Action appears to interpret the entire radio access network 200 as an overlapping routing area. Such interpretation is strained and would be rejected by the person skilled in the art as contrary to convention and 3GPP specification.

Further, U.S. Patent 6,131,030 to Schon et al only stores (for handover purposes) the signaling network address of only the adjacent RNCs, not all RNCs. See, e.g., col. 5, lines 45 - col. 6, line 13 of Schon. If it were assumed *arguendo* that Schon's entire RAN 200 qualified for an overlapping routing area, then each RAN of Schon would (contrary to Schon's teaching) have to store the network addresses of ALL RNCs in the RAN, since Applicants' claims require storing addresses of "any of the plural radio network controllers which controls a cell in any overlapping routing area".

Therefore, the strained equating of an entire RAN to an overlapping routing area is unfounded and incorrect.

Furthermore, with reference to at least claims 7 - 12 and new claims 13 - 18, U.S. Patent 6,131,030 to Schon et al has nothing to teach or suggest with reference to signaling of a routing area update request message. Schon pertains only to handover scenarios between RNCs, not to routing area updates.

As a further deficiency, acknowledged by the Office Action, Schon fails to disclose including in the signaling message the address of the second radio network controller. The Office Action unsuccessfully attempts to augment Schon in a concocted combination with US Patent 6,216,004 to Tiedemann.

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Yet the Office Action has failed to address Applicants' previous defusing of US Patent 6,216,004 to Tiedemann. As previously stated, the cited passages of US Patent 6,216,004 to Tiedemann (col. 20, lines 52 - 57 and col. 21, lines 13 - 22) do not appear even to concern messages between radio network controllers. Instead, the communications referenced in the cited passages of Tiedemann appear to concern base stations. As such, there appears to be no credible basis for combining Tiedemann with Schon, or any semblance of claimed subject matter resulting from the improper combination.

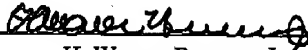
#### D. MISCELLANEOUS

In view of the foregoing and other considerations, all claims are deemed in condition for allowance. A formal indication of allowability is earnestly solicited.

The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Should the Examiner feel that an interview with the undersigned would facilitate allowance of this application, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,  
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